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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/601,395

06/23/2003

James Bradley Enlow

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06/08/2004

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/601,395

Applicant(s)

ENLOW, JAMES BRADLEY

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 9/29/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/29/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 12 is objected to because of the following informalities: The words "bed", "rom" appear to be misspelled. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-11, 16, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "said joint" in line 5. There is insufficient antecedent basis for this limitation in the claims. In claim 1 lines 6-7 the second occurrence of "said outer and inner surfaces" does not make sense. Claims 5 and 16 recite the limitation "a density of from about 2/8-34 lbs/ft<sup>3</sup>" in lines 1-2. There is insufficient antecedent basis for this limitation in the specification. Claims 9 and 20 recites the limitation "said ratio" in line 1. There is insufficient antecedent basis for this limitation in the specification. Claims 2-4, 8, and 10-11 are rejected for depending on a rejected base claim.

### ***Double Patenting***

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Applicant is advised that should claims 8 and 19 be found allowable, claims 10 and 21 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2001-46568 in view of Manual.

2001-46568 discloses a grip having a length from about 4-14 inches (Figure 2, Col. 2, Lns. 30-32), a small outboard end, an axial bore, and a body thickness between an outer and inner surfaces, and an outer surface presenting a reverse taper surface section between an outboard and inboard ends with a body thickness increasing along the length of the section from a smaller thickness nearer an outboard end to a greater thickness nearer an inboard end (Fig. 2) in order to stabilize the gripping of a club to improve swing stability (English Abstract). 2001-46568 does not disclose the exact ratio of greater thickness to a smaller thickness but shows different degrees of outer surface tapering from cylindrical to a significant taper (Figs. 5c, 5d, 6a, 6b, 6c) and a shaft substantially cylindrical (Fig. 2). Clearly an artisan skilled in the art of forming reverse tapered grips with a substantially cylindrical shaft would have selected a suitable thickness change in which a ratio of greater thickness to a smaller thickness being from 1.3 to 1.5 is included.

2001-46568 lacks a ratio of greater thickness to a smaller thickness being from 1.3 to 1.5, a grip being a resilient synthetic resin material of polyurethane foam, a grip density from about 2.8 to 3.4 lbs/ft<sup>3</sup>, and a grip material having an indentation force deflection from 30-80lbs.

Manual discloses a grip having a resilient synthetic resin material comprising a polyurethane foam (Col. 4, Lns. 28-45) and an EVA resin having a density of .12-.3 grams/cm<sup>3</sup> and a hardness of 40-70 in the ASTM D2240C (Col. 5, Lns. 3-18) in order

Art Unit: 3711

to have a light weight grip, material which absorbs shock, and firm support (Col. 3, Lns. 10-27). Manual does not disclose the density or indentation force deflection value of the polyurethane foam but clearly an artisan skilled in the art to form a light weight grip with a sufficient rigidity would have selected a suitable density and indentation force deflection in which a grip density from about 2.8 to 3.4 lbs/ft<sup>3</sup> and a grip material having an indentation force deflection from 30-80lbs are included. In view of the patent of Manual it would have been obvious to modify the grip of 2001-46568 to be made of a polyurethane foam in order to have a light weight grip, material which absorbs shock, and firm support. In view of the patent of Manual it would have been obvious to modify the grip of 2001-46568 to have a grip density from about 2.8 to 3.4 lbs/ft<sup>3</sup> and a grip material having an indentation force deflection from 30-80lbs in order to have a sufficiently rigid grip for a golfer who prefers more support.

It would have been obvious to modify the grip of 2001-46568 to have a ratio of greater thickness to a smaller thickness being from 1.3 to 1.5 in order to stabilize the swing for a golfer who prefers a larger reverse taper.

8. Claims 1, 7-10, 12, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over 4,736,950 in view of 2001-46568 and Manual.

4,736,950 discloses a golf club (Col. 1, Ln. 31), a grip having a length from about 4-14 inches (Fig. 5A, equation (7)), a small outboard end D1 as compared to D3 (Figs. 5A and 5B), and an outer surface presenting a reverse taper surface section in the form of L2 between an outboard and inboard ends (Fig. 5A), an elongated region of

substantially constant diameter extending from a reversed taper section towards an inboard end (L3), L3 having a length of 1-4 inches (Fig. 5A, equation 7), and a ratio of L4 to (L3 +L2 +L1) being from 4-7 (Fig. 5A, equation 7).

4,736,950 lacks an axial bore, a body thickness between an outer and inner surfaces, a body thickness increasing along the length of the reverse taper surface section from a smaller thickness nearer an outboard end to a greater thickness nearer an inboard end, L3 being a constant thickness region, a head with a shaft extending from, a free end of a shaft remote from a head, a ratio of greater thickness to a smaller thickness being from 1.12 to 1.7, and a grip being a resilient synthetic resin material.

2001-46568 discloses a grip having a substantially cylindrical shaft with the outer surface of a grip changing due to the thickness of the grip changing (Fig. 2), a grip having an axial bore, a head with a shaft extending from, a free end of a shaft remote from a head, and an outer surface presenting a reverse taper surface section between an outboard and inboard ends with a body thickness increasing along the length of the section from a smaller thickness nearer an outboard end to a greater thickness nearer an inboard end (Figs. 2, 4B). 2001-46568 does not disclose the exact ratio of greater thickness to a smaller thickness but shows different degrees of outer surface tapering from cylindrical to a significant taper (Figs. 5c, 5d, 6a, 6b, 6c) and a shaft substantially cylindrical (Fig. 2). In view of the reference of 2001-46568 it would have been obvious to modify the club of 4,736,950 to have a substantially cylindrical axial bore with the outer shape of the grip being formed due to the change in thickness of a grip in order to fit a grip over a substantially cylindrical shaft. As such a body thickness would increase

along the length of the reverse taper surface section from a smaller thickness nearer an outboard end to a greater thickness nearer an inboard end and L3 would be a constant thickness region. In view of the reference of 2001-46568 it would have been obvious to modify the club of 4,736,950 to have a ratio of greater thickness to a smaller thickness being from 1.12 to 1.7 in order to provide sufficient support and vibration absorption to a golfer. In view of the reference of 2001-46568 it would have been obvious to modify the club of 4,736,950 to have a head with a shaft extending from and a free end of a shaft remote from a head in order to maximize the velocity of a head at impact.

Manual discloses a grip having a resilient synthetic resin material comprising a polyurethane foam (Col. 4, Lns. 28-45) in order to have a light weight grip, material which absorbs shock, and firm support (Col. 3, Lns. 10-27). In view of the patent of Manual it would have been obvious to modify the grip of 4,736,950 to be made of a polyurethane foam in order to have a light weight grip, material which absorbs shock, and firm support.

9. Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2001-46568 in view of Manual as applied to claims 1-6 and 12-17 above, and further in view of Rife.

2001-46568 lacks a bore having a greater diameter than the diameter of a bore at an inside end. Rife discloses a bore having a greater diameter than the diameter of a bore at an inside end (Fig. 2). In view of the patent of Rife it would have been obvious



Art Unit: 3711

to modify the grip of 2001-46568 to have a bore having a greater diameter than the diameter of a bore at an inside end in order to fit a grip onto a tapered shaft.


***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jacques, WO 00/16858, and Garrity (3,295,850 and 3,441,276 disclose reverse tapered sections.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 1 June 2004

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**